

U. S. Appl'n No. 10/017,991

Reply under 37 CFR 1.116 - Expedited Procedure –
Technology Center 2600
Page 7

REMARKS**Amendments to the claims that are proposed**

Claims 33 and 40, the two independent claims present in this application, are proposed to be amended to add the following limitation:

wherein the part replacement information is information comprising: information identifying said at least one part required for replacement; and information identifying at least one parts supplier dealing with the part required for replacement.

Support for this limitation may be found in the specification of the application as filed, such as, *e.g.*, Figures 1 and 14 and the corresponding portions in the specification. It is believed that allowing the proposed amendments to claims 33 and 40 will not require a new search because the addition of the quoted limitation simply explicitly defines the term "part replacement information" already used in those claims.

The claims remaining in this application are to be the same as before the proposed amendments, namely, claims 33-53.

Discussion

The Office Action mailed on October 20, 2005 rejected Claims 33-53 under 35 U.S.C. 103(a) as being unpatentable over Gormley (U.S. patent 5,513,107) in view of Sheldon, *et al.* (U.S. patent 5,765,143). This was a final action.

The Examiner is respectfully requested to enter the proposed amendments because they would be proper under 37 C.F.R. § 1.116(b)(2) ("[a]n amendment presenting rejected claims in better form for consideration on appeal may be admitted"). It is believed that the proposed amendments to claims 33 and 40, by adding an additional limitation in order to more specifically define "part replacement information," will present the pending claims in better form for appeal.

In addition, the proposed amendments are believed to be proper under 37 C.F.R. § 1.116(b)(3) ("[a]n amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented"). The Examiner will recall that that the final office action provided

U. S. App'n No. 10/017,991

Reply under 37 CFR 1.116 - **Expedited Procedure** -
Technology Center 2600
Page 8

what the Examiner described as "new ground(s) of rejection." In addition, the Examiner located and cited a new reference (Sheldon, *et al.*) against the pending claims.

Furthermore, it is believed that entry of the proposed amendments will place this application in condition for allowance.

Discussion

The Examiner states that Gormley (U.S. patent 5,513,107) suggests the limitation, "an acquiring device that acquires part replacement information from parts suppliers related to replacement of at least one part required for replacement, in a case where it is determined by the determining device that at least one part required for replacement exists," (this limitation is from independent claim 33; independent claim 40 has corresponding step limitations) because Gormley teaches serving vehicles at a dealer (col. 8, lines 37-50). However, it is respectfully submitted that this understanding is incorrect.

In col. 8, lines 37-50, Gormley discloses that

In the event the diagnostic data indicate that a fault is present or suggest that a fault is imminent, the service center communicates an appropriate notice to the vehicle controller 102 of the vehicle 100. The vehicle controller 102 advises the operator of the vehicle 100 of the problem via the display 100 [sic, should be 110] at the appropriate time. However, for non-urgent concerns, the operator of the vehicle may be contacted by the dealer with a detailed description at a time convenient to the vehicle operator. The operator of the vehicle 100 is thus advised to take the vehicle 100 to be serviced if necessary with the urgency of the service required being reflected in the service notice.

As clearly described in the above portion, Gormley merely discloses that the service center advises the operator of the vehicle of an imminent problem via the vehicle controller. Gormley merely suggests that the service center advise the operator of the vehicle on the necessity of non-urgent service via the dealer. That is, Gormley does not disclose, teach or suggest that the service center advises the operator of the vehicle, via the vehicle controller, of information about the dealer at which the vehicle can be serviced.

U. S. Appl'n No. 10/017,991

Reply under 37 CFR 1.116 - Expedited Procedure -
Technology Center 2600
Page 9

Further, the Examiner is invited to notice the description in Gormley at col. 4, lines 21-24, "[a]s suggested in FIG. 2, the dealer 106 may communicate with the vehicle controller 102 by means of a separate connection through the vehicle interface 108 or otherwise." This disclosure teaches a direct connection between the dealer and the vehicle controller 102 (presumably when the vehicle 100 is in the shop), rather than through the external communications subsystem 144 (see Figure 2 and col. 5, lines 45-54 of Gormley) and the service center.

Gormley clearly does not teach or suggest any connection between the dealer and the service center in which information about the dealer is transmitted to the service center. Therefore, the service center cannot transmit the information about the dealer to the operator of the vehicle.

On the other hand, in the present invention, a service center transmitting device transmits the part replacement information, which is defined in the independent claims 33 and 40, according to the proposed amendments, to be "information comprising: information identifying said at least one part required for replacement; and information identifying at least one parts supplier dealing with the part required for replacement." Gormley does not disclose, teach or suggest this feature at all.

In addition, the Examiner states that Sheldon, *et al.* teaches a host computer (acquiring device) receiving order information for vehicle parts (acquiring part replacement information). See Sheldon, *et al.* at Fig.3 and col.6, lines 56-67. He suggests that the subject matter of the claims may be obtained by combining Sheldon, *et al.* and Gormley. However, this understanding is incorrect.

In col.6, lines 56-67, Sheldon, *et al.* disclose, "FIG.3 is a block diagram of another preferred embodiment of the inventive system, including a network comprising programmed computers 2, 3, 4, 5, . . . , and *n* (where "*n*" is a number greater than two), and programmed computer 50. Each of computers 2, 3, 4, 5 . . . , and *n* is operated by personnel of a retail store at a first 'vertical' level of a part distribution chain (in the sense described above with reference to FIG. 2). Computer 50 is a host computer which generates 'order data' in accordance with the invention in response to 'reference data' (of the type described above with reference to FIG. 2) received from computers 2, 3, 4, 5, . . . , *n*."

U. S. App'n No. 10/017,991

Reply under 37 CFR 1.116 - **Expedited Procedure** -
Technology Center 2600
Page 10

Further, the Examiner is invited to notice the description in Sheldon, *et al.* at col. 6, lines 6-11: "[f]or convenience, the expression 'reference data' will be employed to denote the sales data, inventory data, demographics data (such as vehicle population data), and/or market data processed during generation of order data in accordance with the invention."

As clearly described in the above portions, Sheldon, *et al.* merely disclose that the host computer receives information about parts in the retail stores, such as sales data and the retail stores' inventories. That is, this information about inventories does not relate to a part required for replacement. There is no description about the parts required for replacement in Sheldon, *et al.* Therefore, Sheldon, *et al.* do not disclose, teach or suggest that the host computer advises end-user customers on information about a parts supplier that deals with the part required for replacement.

Accordingly, if an ordinarily skilled person combines Sheldon, *et al.* and Gormley, he or she would have a teaching of a system in which the host computer or the service center provides the operator of the vehicle with information about the retail store's sales data or inventory. This is not information that is relevant and specific to the part required for replacement. The operator cannot obtain "information comprising: information identifying said at least one part required for replacement; and information identifying at least one parts supplier dealing with the part required for replacement."

On the other hand, the claimed subject matter, as proposed to be amended, discloses (in claim 33) a service center transmitting device that transmits the part replacement information, which is information comprising: information identifying said at least one part required for replacement; and information identifying at least one parts supplier dealing with the part required for replacement. (Claim 40, as proposed to be amended, teaches the steps of transmitting and notifying this information to the mobile unit.) Therefore, a user can quickly find the parts supplier which has a necessary part and can provide service to the user's vehicle.

It is believed that Gormley and Sheldon, *et al.*, separately or together, do not disclose, teach, or suggest the claimed subject matter and that the proposed amendment further distinguishes the claimed subject matter from that disclosed in the cited references. It is therefore submitted that the proposed amendments should be entered. Furthermore, the rejection of the pending independent claims, and thus their dependent claims, should be withdrawn.

U. S. Appl'n No. 10/017,991

Reply under 37 CFR 1.116 - **Expedited Procedure** --
Technology Center 2600
Page 11

Conclusion

Claims 33-53 should be amended as proposed above in order to put this application in better condition for appeal. In addition, the Applicants submit that the application will also be in condition for allowance and respectfully urge the Examiner to pass this case to issue. The Examiner is respectfully invited to telephone the undersigned attorney as needed in order to advance the examination of this application.

* * *

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office (USPTO) on the date shown below. Specifically, this correspondence is being telefaxed to Primary Examiner Allan Hoosain at the USPTO at 571-273-8300.

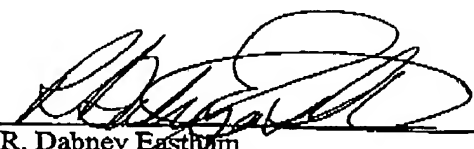
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(Date of Transmission)

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